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08/901,692	07/28/97	KAMAKURA	A 1095.1076/JD

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LM02/1125

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2765

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DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/901,692

Applicant(s)

Kawasaki-Shi et al.

Examiner

Hani Kazimi

Group Art Unit

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☒ Responsive to communication(s) filed on Jul 28, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This application has been reviewed. Original claims 1-10, are pending. The rejections cited are as stated below:

Title Objection

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. While your disclosed invention, as described in the description part of the specification does maintain a marketing system, the claimed invention relates more specifically to a marketing system for processing market information of consumers and dealers through an electronic network. A new title is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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4. Claim 1, is rejected under 35 U.S.C. 102(e) as being anticipated by Fraser (U.S. Patent No. 5,664,115).

Claim 1, Fraser teaches a marketing system for processing market information of consumers and dealers via an electronic network, comprising:

personal information registering means for registering personal information of a consumer (column 3, lines 22-25; and column 5, lines 48-54);

market information registering means for registering market information about goods which the consumer desires to purchase (column 5, lines 16-21; and column 6, lines 42-48);

posting means for extracting and posting the market information registered in said market information registering means according to genres (column 5, lines 55-60; and column 6, lines 49-53); and

personal information acquiring means for acquiring personal information of the consumer necessary for a dealer to access the consumer from said personal information registering means when the market information posted at said posting means is purchased by the dealer (column 7, lines 1-18).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

7. Claims 2-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (U.S. Patent No. 5,664,115) in view of Lalonde et al. (U.S. Patent No. 5,283,731).

Claims 2, and 3, Fraser teaches the personal information acquiring means includes prior approval demand determining means for determining, based on the personal information registered in said personal information registering means, whether or not prior approval of the consumer is required before the dealer accesses the consumer (column 5, lines 36-47).

Fraser fails to explicitly teach that the market information has been purchased by the dealer.

However, Lalonde teaches that the consumer is the person who registers the purchased market information (column 3, lines 42-51).

Both Fraser and Lalonde fail to teach that access confirming means for seeking approval

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for the dealer's access from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required, and access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access.

Official notice is taken that access confirming means for seeking approval for the dealer's access from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required, and access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Fraser to include the access confirming means for seeking approval for the dealer's access from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required, and access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access, since the consumer is the person who registers the purchased market information because, it will provide a secure system, and prevents any confidential information of the consumer being supplied to other users.

Claims 4, and 5, Fraser teaches the personal information registered in said personal

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information registering means includes a type of access to the consumer (column 5, lines 36-66);
and

the type of access includes at least one of indirect or direct electronic mail, indirect or direct facsimile transmission, indirect or direct mail of material, telephone call, and visit (column 5, lines 36-66).

Claim 6, Fraser teaches the personal information registered in said personal information registering means includes pre-categorized information and format-free information (column 5,

Claim 7, Fraser teaches the accounting means for charging the dealer when the dealer has purchased the market information posted at said posting means (column 6, lines 32-40).

Claim 8, Fraser teaches the continuation confirming means for performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market information to be continuously posted at said posting means (column 8, lines 23-27).

Fraser fails to explicitly teach the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information; and

the point providing means gives the consumer an extra point if the consumer purchases goods from the dealer who has purchased the market information.

Official notice is taken that point providing means for giving the consumer a bonus point

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when the consumer has registered the personal information or market information; and

the point providing means gives the consumer an extra point if the consumer purchases goods from the dealer who has purchased the market information is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to implement the system of Fraser to include the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information and when the consumer purchases goods from the dealer because, it would be an advantage to the buyer to save, and to the seller to enhance the sales.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Schumacher et al. US Patent 5,060,165 Oct. 22, 1991.
- b) Shepley US Patent 5,478,989 Dec. 26, 1995.
- c) Gardner et al. US Patent 5,758,327 May 26, 1998.
- d) Hartman et al. US Patent 5,758,324 May 26, 1998.

9. Any inquiry concerning this statement or earlier statements from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached on Monday - Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiners' supervisor, Allen MacDonald, can be reached at (703) 305-9708. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi.

November 20, 1998.



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